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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,235	08/19/2004	Nicholas Arthur Scott	RR-569 PCT/US	3884
20427	7590	06/16/2006	EXAMINER	
RODMAN RODMAN 7 SOUTH BROADWAY WHITE PLAINS, NY 10601			AUGUSTIN, EVENS J	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/505,235	<b>Applicant(s)</b> SCOTT, NICHOLAS ARTHUR	
	<b>Examiner</b> Evans Augustin	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15, 17-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This is in response to an amendment file on 3/16/2006 for letter for patent filed on 8/19/2004. In the amendment, claims 1-3, 5-15, 17-27 have been amended. Claims 4 and 16 have been cancelled. Claim 28 has been added. Claims 1-3, 5-15, 17-28 are pending in the letter.

***Response to Arguments***

1. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 3/16/2006, but has not found those arguments to be persuasive.

**Argument 1:** Prior Art by Planke and Ranieri do not teach the aspect of a programmable card

**Response 1:** Planke discloses an invention relates to a system for the sale of consumer goods, where the purchaser of an article at the place of purchase collects one or more non-validated card symbols of the article, where data carried on the symbol of the article are read and registered, where such data are converted to a price for the article which is paid by the purchaser of the article, where the purchaser of the article receives a validated symbol of the article, and where the article is dispensed to the purchaser at a dispensing location in return for his/her depositing the validated symbol of the article.

Ranieri describes an invention that relates to an information handling system by way of touchscreen terminals. The invention more particularly relates to the entering, displaying and processing of text of various human languages consisting of multi-byte characters when the text is entered by means of a touchscreen terminal keyboard into a programmed computer system (column 1, lines 5-12). Particularly, Ranieri's invention is applicable to self-service kiosks to

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provide the plurality of functions required in such an application, including touchscreen, speaker, digital video/audio, magnetic stripe/chip card reader, receipt printer, statement printer, laser printer, ticket printer, bankbook printer, PIN pad generic device (column 4, lines 63-67, column 5, lines 1-7).

With regard to the programmable card, claims 7 and 22 of the applicant's invention teach the limitation of a card having information selected from the group of: a numerical code, a bar code, an EAN code, a UPC code, a magnetically readable code, an rf label readable code, a series of numbers, a series of letters, a series of a combination of numbers and letters, at least one row of punched holes, a programmable IC chip, and a pre-programmed IC chip. Planke teaches an optically readable card with data containing the item to be purchased in the form of a serial number (column 2, lines 12-16). The type of information in the card can be a bar code and magnetically readable code (column 3, lines 42-43), or EAN code (column 5, lines 41).

**Argument 2:** Obviousness is based entirely on hindsight

**Response 2:** "Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) Application stands finally rejected. For example, motivation to combine prior art references may exist in the nature of the problem to be solved (Ruiz at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (National Steel Car v. Canadian Pacific Railway Ltd., 357 F.3d 1319,

1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)). In this case the motivation the motivation was found in the prior art by Ranieri (column 3, lines 27-32).

### ***Status of Claims***

2. Claims 1-3, 5-15, 17-28 have been examined.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-15, 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Planke (U.S 5902984), in view of Ranieri (U.S 6281886).

As per claims 1-3, 5-15, 17-28, Planke discloses an invention relates to a system for the sale of consumer goods, where the purchaser of an article at the place of purchase collects one or more non-validated card symbols of the article, where data carried on the symbol of the article are read and registered, where such data are converted to a price for the article which is paid by the purchaser of the article, where the purchaser of the article receives a validated symbol of the

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article, and where the article is dispensed to the purchaser at a dispensing location in return for his/her depositing the validated symbol of the article. The computer system includes:

- An optically readable card with data containing the item to be purchased in the form of a serial number (column 2, lines 12-16). The uniqueness of the serial number implies that is generated serially.
- A merchandise dispensing unit to dispense merchandise in accordance with the corresponding serial number (column 2, lines 17-18)
- A checkout unit (cash register), where the optically readable card is validated (column 2, lines 25-30)
- A comparator unit to reconcile the information received by dispensing unit (column 4, lines 26-29)
- The type of information in the card can be a bar code and magnetically readable code (column 3, lines 42-43), or EAN code (column 5, lines 41)
- After the card is validated at the check out unit, the validation signal is sent to the merchandise dispenser to be able to recognize and accept the validated card before dispensing the merchandise (column 4, lines 21-50, column)
- The ability to transmit the validation signal from the check out unit to the merchandise dispenser via a connection (column 4, lines 44-45, figure 1, items 9 and 15)
- The check out unit includes a scanner or a bar code reader (column 3, lines 49-51)

Planke did not explicitly describe a method/system in which the initial non-validated card/token/ticket is dispensed by a mechanism such as dispensing unit. However, Ranieri describes an invention that relates to an information handling system by way of touchscreen terminals. The invention more particularly relates to the entering, displaying and processing of text of various human languages consisting of multi-byte characters when the text is entered by means of a touchscreen terminal keyboard into a programmed computer system (column 1, lines 5-12). Particularly, Ranieri's invention is applicable to self-service kiosks to provide the plurality of functions required in such an application, including touchscreen, speaker, digital video/audio, magnetic stripe/chip card reader, receipt printer, statement printer, laser printer, ticket printer, bankbook printer, PIN pad generic device (column 4, lines 63-67, column 5, lines 1-7).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to combine Planke's invention of a merchandise dispenser that validates/reads validation card/token/ticket with Ranieri's invention that relates to the entering, displaying and processing of text of various human languages consisting of multi-byte characters when the text is entered by means of a touchscreen terminal keyboard into a programmed computer system.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the two inventions because it would provide for self-service terminals/kiosks which include touchscreens for entering into a computer system text and information consisting of multi-byte characters or multiple multi-byte characters of human languages as well as single byte character languages (column 3, lines 27-32).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin

June 6, 2006

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*Bleeker Jones P.*  
PRIMARY EXAMINER